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EXAMINER

JAMI, HARES

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/658,584	Applicant(s) BERINGER ET AL.	
	Examiner HARES JAMI	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-20,25 and 27-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-20,25 and 27-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/08/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in response to the amendment filed on November 26, 2007.

Claims 1, 3-20, 25, and 27-38 are pending in this Action.

Claims 2 and 26 had been previously cancelled.

Claims 21-24 had been withdrawn from consideration previously.

Response to Amendment

In response to the Office Action mailed 07/08/2008, claims 1 and 25 have been amended, no new claim has been cancelled, and new claims 37-38 have been added.

The Applicant's argument regarding specification objection has been considered but are not persuasive. Therefore, prior specification objection is maintained.

The Applicant's arguments regarding 35 USC 101 rejections have been considered but are not persuasive. Therefore, prior 35 USC 101 rejections are maintained.

Applicant's arguments with respect to newly amended claims 1 and 25 have been considered but are moot in view of the new ground(s) of rejection. The newly amended limitations necessitate the finality of the Actions.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 09/08/2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the Examiner.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claims 25, 27-36 recite the limitation of "machine-readable storage medium" which is not specified in the specification. The specification specifies the subject matter of "machine readable medium"; however, the Applicant fails to define the "machine-readable storage medium".

Claims

The Applicant is advised to cancel all the withdrawn claims (Claims 21-24) in response to this Office Action because they seem pending and in case of allowance they need to be cancelled.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 27-36 are rejected under 35 U.S.C. 101.

Regarding claims 25 and 27-36,
the specification of the instant application fails to define the subject matter of "machine-readable **storage** medium". It is not clear that what type of medium the Applicant considers as "machine-readable **storage** medium". Moreover, the Applicant describes that the term "machine-readable medium" refers to any **computer program product** ([0063], lines 4-5). The computer program product is software *per se*. Therefore, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Further more, claims 25 and 27-36 are rejected under 35 U.S.C. 101 for failing to place the invention squarely within one statutory class of invention. On page19, paragraph [0063], lines 7-10 of the instant specification specifies that “including a machine-readable medium that receives machine instructions as a machine-readable signal”. Therefore, applicant has provided evidence that applicant intends the “medium” to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7-13, 19-20, 25, 27-31, and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert, US Patent No. 5,721,906 issued Feb. 24, 1998 in view of Cook et al., US Patent No. 6,820,082 B1 filed on Apr. 3, 2000 (Cook, hereafter) further in view of Singh et al., US Publication No. 2003/0130994 A1 filed on Sep. 26, 2002 (Singh, hereafter) and further in view of Abbott et al., US Patent No. 2003/0046401 A1 (Abbott, hereafter).

Regarding claim 1,

Siefert discloses a method comprising:

- Creating a data source of resource profiles associated with a plurality of resources, the resources being of a resource type (Siefert discloses creating different types of resource profiles for as books, movies, and documents, see Fig. 40-54 showing creating of resource profiles, col. 4, line 65 through col. 5, line 56, and col. 18, lines 6-27, Siefert);
- Receiving, through a user interface, first attributes of a resource desired by a user (Note that the Applicants on page 7, paragraph 32, of the instant application describe a document as a type of resources and its title, author, publication date, and topic as attributes. Siefert discloses a user interface receiving search words such as "Title" of documents, book, or movies, as a first attributes of a desired resource, see Fig. 9 and col. 10, lines 44-46, Siefert);

- searching a data source of resource profiles for profiles having one or more of the first attributes (Siefert discloses that the profiles of resources are searched to locate the resource of interest such as books, movies, and documents, which has the first attributes, such as “Title”, see Col. 4, lines 31-33 and col. 4, line 65 through col. 5, line 26, Siefert);
- providing a hit-list of resources having the one or more first attributes (Siefert discloses a hit-list of resources [a list of documents] that has the first attribute of “Title”, which here is “Unix”, see Fig. 10-11, Siefert);

Siefert discloses the above limitations of claim 1. Siefert further discloses a modifying (i.e., editing) of resource profiles (see “New” and “modify” buttons in Fig. 41-49 and col. 9, line 50 et seq., Siefert). However, Siefert does not clearly disclose approving whether or not a user can edit the resource profiles and editing the resource profiles based on the approval. On the other hand, Cook discloses that security rules control who can edit the organization and person profiles (i.e., resource profiles) and may allow a certain people (i.e., users) to edit the profiles; in another word, the security rules approve whether or not a person (i.e., a user) can edit the resource profile, and after the allowing (i.e., approving) the person can edit the profiles (see col. 9, line 4 through col. 10 line 63, Cook). Siefert and Cook are from the same field of database accessing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made having the teachings of Siefert and Singh before him/her to modify the method of searching resource profiles of Siefert with Cook’s teaching. A skilled artisan would have been motivated to incorporate the technique of allowing (i.e.,

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approving) whether or not a person (i.e., a user) can edit the organization and person profiles (i.e., resource profiles) and editing the profiles after the allowance, as taught by Cook (see col. 9, line 4 through col. 10 line 63, Cook) into the teaching of modifying of resource profiles of Siefert in order to approve whether or not a user can edit the resource profiles and edit the resource profiles based on the approval. The motivation for doing so, as taught by Cook, would have been to increase the security of the system by controlling the access and approving a certain users to access the profiles (see col. 1, lines 40-47 and col. 9, lines 4-30, Cook).

The combination of Siefert in view of Cook discloses receiving the first attributes (i.e. "Titles" of documents or books) and providing a search list based on that said first attributes (see above). However, it is silent with respect to receiving second attributes of the resource through a refinement user interface, searching the hit-list for resources having the second attributes; and providing a narrowed hit-list of resources having the first and second attributes. On the other hand, Singh discloses a method, system and software for retrieving information bases on front and back matter data, which is form the same field of endeavor of retrieving information ([0006], Singh). Singh discloses "authors" and publishers as second attributes ([0118]-0132], Singh). Singh further teaches the technique of further narrowing the result pages [which contains the hit list from the first attributes] by providing the user with specific search criteria and instructing to narrow the search parameters, such as narrowing down by "authors" which reads on the second attributes ([0079], [0163], [0204], lines 5-8, Singh), the new narrowed search results contains both the first and second attributes (i.e., both "title" and

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“authors” attributes). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made having the teachings of Siefert, Cook, and Singh before him/her to further modify the method of searching resource profiles of the combination of Siefert in view of Cook with Singh’s teachings. A skilled artisan would have been motivated to incorporate the technique of narrowing down the result pages of Singh and using the “authors” as second attributes with the method of searching resource profiles of the combination of Siefert in view of Cook in order to receive second attributes of the resource through a refinement user interface, search the hit-list for resources having the second attributes; and provide a narrowed hit-list of resources having the first and second attributes. A good motivation for doing so would have been reducing the number of selected non-relevant resources with increasing the chance of selected relevant resources.

The combination of Siefert in view of Cook and further in view of Singh teaches all the limitations as stated above. However, it does not clearly teach selecting a layout of the user interface from a plurality of layouts based on the first attributes. On the other hand, Abbott discloses dynamically selecting an appropriate user interface (UI) from multiple UIs based on the current UI needs (e.g., current task being performed) and based on attributes, such as attributes that corresponds to a theme or specific individual or group (see at least [0030] and [0079]-[0111], Abbott). Abbott is from the same field of endeavor of data processing. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of the combination of Siefert in view of Cook and further in view of Singh with Abbott’s

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teaching. A skilled artisan would have been motivated to incorporate the technique of selecting an appropriate user interface (UI) from multiple UIs based on the current UI needs (e.g., current task being performed) and based on attributes, such as attributes that corresponds to a theme or specific individual or group, as taught by Abbott (see at least [0030] and [0079]-[0111], Abbott) into the teaching of retrieving the profile based on the first attributes of the combination of Siefert in view of Cook and further in view of Singh in order to select a layout of the user interface from a plurality of layouts based on the first attributes. The motivation for doing so would have been to increase the flexibility and efficiency of the system by presenting the information on a UI that is most optimal and appropriate to a user based on analyzed attributes.

Regarding claim 3,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott teaches displaying, in response to a user query, resources of the hit-list for user inspection (Siefert discloses displaying a hit-list of resources [a list of documents] that has the first attribute of "Title", which here is "Unix", for the user inspection, see Fig. 10-11, Siefert); maintaining a list of resources displayed for inspection by the user (Singh discloses retaining [i.e., maintaining] some of retrieved information based on an indication by the user which is inspected by the user [see [0019], Singh]); Displaying a search history of search queries previously entered by a user, including a list of resources previously displayed (Singh discloses that Search History selection is provided [i.e., displayed] on the screen of Search Selection, see [102], lines 1-2, Singh) ; allowing a user to back navigating to a search within the search

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history by displaying the corresponding hit-list; and displaying the list of inspected resources as the hit-list, (Singh further discloses a Search History saves [i.e., maintaining] a list of search criteria associated with a hit as cookies on the computer that has been done by the user ; the step of accessing the last 20 searches conducted by the user corresponds to the claimed limitation of, allowing the user to navigate back through the previous searches [see [0102] and [0276], Singh]).

Regarding claim 4,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further discloses storing the hit-list as a collection of resources that can be used for further actions or stored as a persistent collection, (Siefert discloses that the user is provided with a retrieved collections of hit-list which can be used for further action of retrieving implying that the hit-list of resources are stored before the retrieving, see Fig. 11-13, and Col. 11, lines 10-15, Siefert).

Regarding claim 5,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further discloses defining resource profiles by facets, attributes, and description of the sources of the attributes (Siefert discloses that a profile contains descriptive information describing the sources of the attributes [i.e., attributes] characterizing resources, like title, product ID, cost, price, and resource description [see col. 4, lines 29-30 and Fig. 48], which corresponds to definition of facet by the Applicant describing facets as set of attributes[see [0020], lines 67, instant application]).

Regarding claim 7,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further discloses storing the narrowed hit-list as a collection of resources, for using for further actions or storing as a persistent collection (this limitation is equivalently taught when Singh discloses retaining some of retrieved information across query session [i.e., a hit-list of resources] on an indication by the user, [see [0019], Singh], and Siefert discloses that the user is provided with a retrieved collections of hit-list which can be used for further action of retrieving implying that the hit-list of resources are stored before the retrieving, [see Fig. 11-13, and Col. 11, lines 10-15, Siefert], which reads on the limitation of storing the narrowed hit-list as a collection of resources, for using for further actions or storing as a persistent collection).

Regarding claim 8,

t the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further discloses storing the collection of resources dynamically or statically, (Singh equivalently discloses the limitation of storing dynamically of resources by teaching that the search criteria [i.e., query] is saved as a cookie [see [0276], Singh], which correspond to the Applicant's description of storing dynamically as storing the query [see [0010], lines 4-5, instant application]; Singh further teaches the limitations of storing statically of resources by teaching that the retrieved information is retained [i.e., saved] by the user indication [see [0019], Singh], which correspond to the Applicant's description of storing statically as storing the hit-list [see [0010], lines 4-5, instant application]).

Regarding claims 9-10,

t the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further discloses aggregating the narrowed hit-list with an existing collection of resources and the existing collection of resources comprises an historical listing of aggregated narrowed hit-lists (Singh equivalently teaches the limitation of aggregating the narrowed hit list to the collection of historical aggregated narrowed hit-lists when he discloses that search results page contains the option of “saving in user file/profile” [see [0287] and [0295], Singh], which saves the results [i.e., selected resources] in a file which can contain other saved results forming an aggregated collection of results. Singh further discloses merging found materials or retrieved information with material selected during earlier searches, see [0509], lines 5-10, Singh).

Regarding claim 11,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further discloses creating segments of the narrowed hit-list by discrete values of an attribute dimension, (Siefert teaches grouping [i.e., segmenting] the resources according to fixed categories [see col. 12, lines 25-29 and Fig. 19, Siefert]; moreover, Singh discloses that the search results screen display a summary segmenting the results by groups of titles, authors, and publishers and showing the statistics of each group which corresponds to attribute dimension limitation, see [0155]-[0158], Singh).

Regarding claim 12,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further discloses comprising providing one or more descriptive statistics associated with the segments, (Singh discloses providing statistical data for the groups of results such as number of titles, or number of authors meet the criteria which forms a group, see [0155]-[0160] and [0287]; Singh);

Regarding claim 13,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further discloses the hit-list is refined to resources associated with a particular descriptive statistic, (Singh discloses refining the search results by selecting the range of authors or specific authors, see [0163], which the statistics data already about authors already provided on the results page, see [0155]-[0157], Singh).

Regarding claim 19,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further discloses using the hit-list to create a community, (Singh discloses that retrieved information or found materials [i.e., hit-list] can be merged with materials that found earlier, and user can share their resources with other users through collaborative tools, which forms a community, see [0509], Singh).

Regarding claim 20,

the combination of Siefert in view of Cook and further in view of Singh further discloses providing contact information in response to a user query to enable communication with resources in the community, (Singh discloses collaborative tools that enable the communication of resources in the community, in which the contact

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information is provided for collaborative tools in order to communicate the resources, see [0509], lines 10-14, Singh).

Regarding claims 25, 27-31, and 33-36,

the scope of claims 25, 27-31, and 33-36 are substantially the same as claims 1, 3-4, 10, 5, 12, 6-7, and 9-11, respectively. Therefore, claims 25, 27-31, and 33-36 are rejected on the same basis as set forth for the rejections of claims 1, 3-4, 10, 5, 12, 6-7, and 9-11, respectively.

Regarding claim 37,

the combination of Siefert in view of Cook and further in view of Singh further discloses wherein the narrowed hit-list is displayed based on the resource type (See [0079], [0163], [0204], and Fig. 8-9, Singh).

Regarding claim 38,

the combination of Siefert in view of Cook and further in view of Singh further discloses wherein the stored hit-list includes a collection of heterogeneous resources (Siefert discloses different types of resource profiles for as books, movies, and documents (see Fig. 40-54, col. 4, line 65 through col. 5, line 56, and col. 18, lines 6-27, Siefert) and also Siefert discloses that the user is provided with a retrieved collections of hit-list which can be used for further action of retrieving implying that the hit-list of resources are stored before the retrieving, see Fig. 11-13, and Col. 11, lines 10-15, Siefert).

Claims 14-16, 18, 6, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert, US Patent 5,721,906, in view of Cook et al., US Patent No.

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6,820,082 B1, further in view of Singh et al., US Publication US 2003/0130994 A1, further in view of Abbott et al., US Patent No. 2003/0046401 A1, and further in view of Coiera et al. ('Coiera', hereafter), US Publication 2005/0086204 A1 (PCT filed on Nov. 20, 2002).

Regarding claim 14,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott discloses all the limitations of claim 1. However, it is silent with respect to receiving a search template by the user. On the other hand, Coiera discloses a system and method for searching data sources, which is from the same field of endeavor of searching data (see Abstract and [004], Coiera). Coiera teaches the technique of selecting a search template according to search parameters by the user (see [0004], lines 5-11, Coiera). Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made having the teachings of the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott to further modify the combination of Siefert in view of Singh system with Coiera teaching. A skilled artisan would have been motivated to incorporate the technique of selecting a search template according to search parameters by the user as taught by Coiera (see [0004], lines 5-11, Coiera) with the method of searching profiles of resources of the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott in order to receive a search template from the user. As Coiera teaches a motivation for doing so would have been to reduce time, effort and skill for novice user to search data sources in most effective way (see [0006], Coiera).

Regarding claim 15,

the combination of Siefert in view of Cook further in view of Singh and further in view of Coiera teaches the search template is defined by the user, (Coiera discloses that the user can create [i.e., define] his search template by saving his Advance Search, see [0061] and [0008], Coiera).

Regarding claim 16,

the combination of Siefert in view of Cook further in view of Singh further in view of Abbott and further in view of Coiera teaches the search template comprises a multi-resource query that returns resources of more than one resource type, (Coiera discloses that query using for the template searching more than one resource type, see Table 1 in [00090], queries are included different type of data sources).

Regarding claim 18,

the combination of Siefert in view of Cook further in view of Singh further in view of Abbott and further in view of Coiera teaches saving and re-using the search template can be saved and reused, (Coiera discloses storing the template on the user's system and using them by the creator [see [0085], lines 7-9, Coiera], and Siefert discloses that the user is provided with a retrieved collections of hit-list which can be used for further action of retrieving implying that the hit-list of resources are stored before the retrieving, [see Fig. 11-13, and Col. 11, lines 10-15, Siefert], which reads on the limitation of saving and re-using the search template can be saved and reused).

Regarding claim 6,

the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott further in view of Coiera teaches generating a pattern-based user interface of a search tool from the resource profile, (Coiera equivalently teaches this limitation by disclosing that a the Advanced Searched can be saved as a search template based on the search criteria and search keywords [see [0061], Coiera], as it is well known in the art a search template is a pattern-based user interface which is generated based on the desired keywords of the user to search for data source which can be a resource profile).

Regarding claim 32,

the scope of claim 32 is substantially the same as claim 6. Therefore, claim 32 is rejected on the same basis as set forth for the rejection of claim 6.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert, US Patent 5,721,906, in view of Cook et al., US Patent No. 6,820,082 B1, in view of Singh et al., US Publication US 2003/0130994 A1, further in view of Coiera et al., US Publication 2005/0086204 A1, and further in view of Nardoizzi et al. ('Nardoizzi', hereafter), US Patent 6,636,837 B1 (patent date: Oct. 21, 2003 filed on Jan. 27, 2000).

The combination of Siefert in view of Cook further in view of Singh further in view of Abbott and further in view of Coiera teaches all the limitation of claim 14. However, it is silent with respect the search template is auto-configured based on the resource type, attributes or facets. On the other hand, Nardoizzi teaches the technique of allowing the automatic customizing of the screen for the user based on the past history or personal

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information of the user (see col. 7, lines 8-15, Nardozzi). Nardozzi and the combination of Siefert in view of Cook further in view of Singh and further in view of Abbott and further in view of Coiera are from the same field of endeavor of displaying information. Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made having the teachings of Nardozzi to modify the combination of Siefert in view of Cook further in view of Singh further in view of Abbott and further in view of Coiera with Nardozzi system. A skilled artisan would have been motivated to incorporate the technique of allowing the automatic customizing of the screen for the user based on the past history or personal information of the user (see col. 7, lines 8-15, Nardozzi) with search template of the combination of Siefert in view of Cook further in view of Singh further in view of Abbott and further in view of Coiera in order to auto-customized (i.e., auto-configured) the search template based on the resource type because it facilitates the searching based on the user preferences resulting in saving time for the user.

Response to Arguments

The Applicant's arguments regarding specification objection and 35 USC 101 rejections have been considered but are not persuasive.

Regarding the Applicant's argument (page 12-13 of Remark) traversing the specification objection arguing that based on MPEP 608.01(o) and 1302.01 "there is no requirement that the language used in the claims be identical to the language in the specification", the Examiner respectfully disagrees.

MPEP 608.01(o) recites that "[n]ote that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner's amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see 37 CFR 1.75(d)(1). If the examiner determines that the claims presented late in prosecution do not comply with 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced." The meaning of the "machine-readable storage medium" is not apparent from the descriptive portion of the specification with clear disclosure as to its import. Although it is not necessary that the Applicant uses the exact terms in claims, however, not specifying the same terminology or its equivalent in the claims leads to confusion as to the scope of the patent. The Applicant needs to make it clear that what type of medium he/she considers as "machine-readable storage medium".

Regarding the Applicant's argument (page 14 of Remark) traversing the 35 USC 101 rejection arguing that "the phrase 'machine-readable storage medium' is clearly supported by the specification of the instant application" and "paragraph [0063] of the

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instant application clearly separated the term 'machine-readable medium' from the term 'machine readable signal'", the Examiner respectfully disagrees.

The phrase "machine-readable storage medium" is not clearly supported by the specification of the instant application and that is why the specification has been objected to. Moreover, paragraph 63 of the instant application clearly discloses that "the term 'machine-readable medium' refers to any computer program product... including a machine-readable medium that receives machine instructions as a machine-readable signal." Therefore, "machine-readable medium" refers to "computer program product" (which is software per se.) and "a machine-readable signal" (which is a form of energy). Both software per se and signal are non-statutory under 35 USC 101. For further information, see above: *Claim Rejections - 35 USC § 101*.

Applicant's arguments with respect to claims 1 and 25 have been considered but are moot in view of the new ground(s) of rejection **in view of Abbott et al., US Patent No. 2003/0046401 A1**.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hares Jami whose telephone number is 571-270-1291. The examiner can normally be reached on Mon to Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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/Hares Jami/
Examiner, Art Unit 2162
01/05/2008

/John Breene/
Supervisory Patent Examiner, Art Unit 2162